

Notice of Allowability

Application No.

10/655,073

Examiner

Tekchand Saidha

Applicant(s)

LUCHE ET AL.

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 04 April 2005.
2. ☒ The allowed claim(s) is/are 1,45 and 50-52.
3. ☒ The drawings filed on 04 September 2003 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
 - * Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date 12/29/2003
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

RD

Notice of Allowability

1. Preliminary amendment filed 9.4.2003 and Information Disclosure Statement filed 12.29.2003 are acknowledged.

2. Applicant's election of group I (claims 1, 45-46 & 50-52) as per response to restriction filed 04 April 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 10, 15-44, 47-49 & 53 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

2. Claims 1, 45-46 & 50-52 are pending and under consideration in this examination.

3. Claims **1, 45 & 50-52** are allowed, subject to the following Examiner's amendment.

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Mae Joanne Rosok on May 6, 2005.

~~Cancel claims 10, 15-44, 46-49 & 53 without prejudice.~~

Amend Applicants' specification as follows:

On page 1 of the instant specification, after
'CROSS-REFERENCES TO RELATED APPLICATIONS'
delete the continuation data on lines 3-4 and replace with the following :
This application is a continuation of United States Application No. 09/619,380 filed July 19, 2000, now U. S. Patent 6,649,391, which application claims the benefit of USSN 60/144,557, filed July 20, 1999, which are incorporated herein by reference in their entireties

Art Unit: 1652

Amend the claims as follows:

In claim 1, line 1, delete 'having' and replace with 'comprising'.

In claim 1, line 2, after 'SEQ ID NO: 2', insert a period (.), and delete the rest of the sentence.

Rewrite claim 45 as follows:

45. A DSP-11 substrate trapping mutant polypeptide that differs from the sequence recited in SEQ ID NO: 2 by a substitution at position 65 or position 95 of SEQ ID NO: 2, such that the polypeptide binds to a substrate with an affinity that is not substantially diminished relative to DSP-11, and such that the ability of the polypeptide to dephosphorylate a substrate is reduced relative to DSP-11.

Amend claim 52 as follows:

52. In claim 52, end of line 1, after 'polynucleotide', delete 'which' and replace with 'wherein the'.

In claim 52, beginning of line 2, delete 'encodes a polypeptide' and replace with 'polypeptide is'.

4. The following is an examiner's statement of reasons for allowance:

This Application provides unobvious DSP-11 polypeptide of SEQ ID NO: 2 and specific substrate trapping mutants thereof, and the encoding polynucleotide.

In view the Examiner's amendment, no prior art reference or sequence of record, taken alone or in combination teach the claimed invention or provide motivation to one of ordinary skill in the art to use the skills available in the area of enzymology or molecular biology, to make the invention obvious.

5. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should

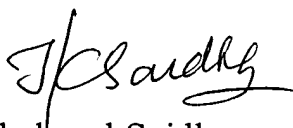
Art Unit: 1652

preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tekchand Saidha (Ph.D.) whose telephone number is (571) 272-0940. The examiner can normally be reached on Monday-Friday from 8:15 am to 4:45 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy, can be reached at (571) 272-0928. The fax phone number for this Group in the Technology Center is 703 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is 571 272-1600.



Tekchand Saidha
Primary Examiner, Art Unit 1652
Recombinant Enzymes, E03A61 Remsen Bld.
400 Dulany Street, Alexandria, VA 22314
Telephone : (571) 272-0940
May 9, 2005